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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 11/14/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,754

Applicant(s)

SCHMIEDING ET AL.

Examiner

Kathleen M Christman

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3713

DETAILED ACTION

In response to the amendment filed 09/09/2003, claim 3 has been cancelled; claims 1, 2, 4, 5, and newly added claims 6-12 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation "a link which opens a channel to a communication network" to claim 1, is not described in the specification as originally filed such that one of ordinary skill in the art could make or use the invention. The closest description appears to be a paragraph 37 where the activation of a link causes a browser to open, which then searches for a communication channel linked to a communication network. There is no description of the link causing the channel to the communication network to be opened. Claims 2 and 4-8 inherit this deficiency through their dependencies and are thus rejected for the same reasons.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The

Art Unit: 3713

preamble of the claim recites "a method for training a user to perform a surgical technique". However, the claim does not set forth a method for performing this function.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Pellegrino et al (US 6149441). Pellegrino et al teaches a method for training users including the steps of: providing an interactive template on a storage medium (the lesson database, element 64 of Fig. 1); accessing the storage medium locally at a workstation (col. 8: 55-59); selecting a link in the interactive template (col. Col. 3: 52-54, col. 14: 32-35); opening a communication channel to an information network outside of the local workstation (internet communication, described throughout the specification); and accessing information from outside the local workstation through the communication channel (the actual viewing of a web-page, see previously cited sections).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3713

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramshaw et al (US 5791907) in view of Ceretta et al (US 6370355 B1). Ramshaw et al teaches an instruction aid for training a user to perform a surgical technique comprising: an interactive template accessible by a user (an interactive user environment, col. 2: 52); an animated demonstration of the surgical technique provided in the interactive template (the images used in the "Perform Surgery" feature); a video recording demonstrating performance of the surgical technique on a patient, provided in the interactive template (the "Observe Surgery" feature) and information relating to any surgical instruments necessary for performing the surgical procedure, provided in the interactive template (the "Instruments" section col. 8: 65-67). Access to published references relating to the surgical technique, as in claim 2, is taught in the "References" section, see col. 8: 59-66.

Ramshaw et al does not specifically teach that the template includes a link to a the website of a company where the user can obtain more information (claim 1), that the link includes the ability for the user to access an area of the company website containing an updated schedule of training courses (claim 4), allows a user to interactively register for a course (claim 5), provides information about the company (claim 6), provides information about the corporate locations of the company (claim 7) or a link to where the user can find out about instruction centers operated by the company (claim 8).

Ceretta et al teaches the use of websites throughout the specification, one example of which is at col. 5: 43-62. A link to a registrations page along with the ability to register for a training course is taught in at least col. 22: 45+ under the section "I-led Schedule". Information about the company including information about the corporate locations of the company can be seen in at least in Figure 5 with the "about Epic" and "contact us" options. Information about the "instruction centers" is shown by the "workshops" as described throughout the Ceretta reference. It would have been obvious to one of ordinary skill in the art to incorporate the web-page based functions of Ceretta into the network enabled

Art Unit: 3713

teaching system of Ramshaw et al so as to provide a user with the ability to seek further information on a topic and schedule attendance in a class in a convenient and efficient manner.

Finally the examiner notes that neither Ramshaw nor Ceretta specifically teach that the link to the corporate website is within the interactive template provided by the locally executed software. However, it is the examiner's position that this is an old-and-well known practice in the field of software distribution. Companies regularly include a hyperlink to their corporate website within their software products to allow a user to quickly access their site for further information about the company or any of its products. As such it would have been obvious to one of ordinary skill in the art to include such a link in the Ramshaw software product.

5. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellegrino et al (US 6149441). Pellegrino et al teaches all elements of the invention as shown above with respect to claim 9. Further Pellegrino et al teaches the ability for the user to access the website of the company providing the interactive template, as in claim 11, in Figure 3. The ability for the student to access the schools (company) homepage is equated to this element of the claims. Pellegrino et al fails to specifically teach that the template includes at least one visual demonstration of a surgical procedure (claim 10). Pellegrino et al teaches the use of visual elements (i.e. videos and animations) in at least col. 11: 17-21. Pellegrino et al does not limit the content of the lesson to any one subject. As such it is the examiner's position that one of ordinary skill in the art could easily modify the lesson content of Pellegrino et al to include a lesson on surgical techniques including a visual demonstration of how to perform the technique and that such a modification is a matter of design choice. It would be obvious to make this modification so as to produce a course suited for teaching surgical techniques.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pellegrino et al (US 6149441) in view of Hitchcock et al (US 5823781). Pellegrino et al teaches or renders obvious all aspects of the claimed invention as shown above with reference to claim 10, but fails to teach that accessing information from outside the local workstation includes registering for a training course offered at a

Art Unit: 3713

location remote to the local workstation (claim 11). Hitchcock teaches the ability for the user to register for "classroom instruction", which is clearly remote from the user's workstation, in col. 5: 37-45. It would have been obvious to one of ordinary skill in the art to incorporate the ability for a user to register for a conventional classroom course into the Pellegrino system so as to allow a user to take a course in a manner they are more comfortable with, as suggested by Hitchcock.

Response to Arguments

7. Applicant's arguments filed 09/09/2003 have been fully considered but they are not persuasive. Applicant has asserted that Ramshaw's "perform surgery" does not initiate an animated demonstration of the surgical procedure. An animation is commonly known as the illusion of movement created by using a succession of static images. As those familiar with video production know videos include a series of static images referred to as frames. Ramshaw, through the use of videos thus uses animated demonstrations. Further, although the user may be asked to answer questions concerning the procedure, videos to demonstrate how the procedure is performed are still shown throughout the procedure. With regards to the newly added claims (6-12) applicant has made the general assertion that the claims are directed to subject matter similar to old claim 3. The examiner respectfully disagrees with this statement, as the limitations specifically recited in these claims were not present in claim 3 as originally presented. The limitations of these claims have been addressed above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date


Art Unit: 3713


of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Kathleen M. Christman


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